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Complete if Known

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Filing Date	April 21, 1999
First Named Inventor	Jerome A. Mouton, Jr.
Examiner Name	Fleurantin, Jean B.
Art Unit	2162
Attorney Docket No.	81862P122

☐ Applicant claims small entity status. See 37 CFR 1.27.

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FEE CALCULATION

Large Entity		Small Entity		Fee Description	Fee Paid
Fee Code	Fee (\$)	Fee Code	Fee (\$)		
1051	130	2051	65	Surcharge - late filing fee or oath	
1052	50	2052	25	Surcharge - late provisional filing fee or cover sheet.	
2053	130	2053	130	Non-English specification	
1251	120	2251	60	Extension for reply within first month	
1252	450	2252	225	Extension for reply within second month	
1253	1,020	2253	510	Extension for reply within third month	
1254	1,590	2254	795	Extension for reply within fourth month	
1255	2,160	2255	1,080	Extension for reply within fifth month	
1401	500	2401	250	Notice of Appeal	
1402	500	2402	250	Filing a brief in support of an appeal	500.00
1403	1,000	2403	500	Request for oral hearing	
1451	1,510	2451	1,510	Petition to institute a public use proceeding	
1460	130	2460	130	Petitions to the Commissioner	
1807	50	1807	50	Processing fee under 37 CFR 1.17(q)	
1806	180	1806	180	Submission of Information Disclosure Stmt	
1809	790	1809	395	Filing a submission after final rejection (37 CFR § 1.129(a))	
1810	790	2810	395	For each additional invention to be examined (37 CFR § 1.129(b))	
Other fee (specify) _____					
SUBTOTAL (2)					(500.00)

SUBMITTED BY

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**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BOARD OF PATENT APPEALS AND INTERFERENCES**

In re Application of:

Jerome A. Mouton, Jr. et al.

Serial No. 09/295,690

Filed: April 21, 1999

For: METHOD AND APPARATUS FOR
UPGRADING A DATABASE IN A
REDUNDANT ENVIRONMENT
BY RELEASE CHAINING

EXAMINER: FLEURANTIN, JEAN B.

ART UNIT: 2162

**APPEAL BRIEF
IN SUPPORT OF APPELLANTS' APPEAL
TO THE BOARD OF PATENT APPEALS AND INTERFERENCES**

Commissioner for Patents
PO Box 1450
Alexandria, Virginia 22313-1450

Sir:

Appellants hereby submit this Brief in support of an appeal from a final decision by the Examiner, mailed on September 9, 2005, in the above-captioned case. Appellants respectfully request consideration of this appeal by the Board of Patent Appeals and Interferences for allowance of the above-captioned patent application.

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D. McGovern
(Signature of person mailing paper or fee)
July 10, 2006
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Application Serial No. 09/295,690
Filing Date: April 21, 1999

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Art Unit 2162
Examiner: Fleurantin, Jean B.

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I. REAL PARTY IN INTEREST

The real party in interest is Cisco Technology, Inc., of Santa Clara, California.

II. RELATED APPEALS AND INTERFERENCES

To the best of Appellants' knowledge, there are no appeals or interferences related to the present appeal that will directly affect, be directly affected by or have a bearing on the decision of the Board.

III. STATUS OF CLAIMS

Claims 1-17 are pending on appeal and stand rejected. The Appellants appeal the rejections of claims 1-17. A copy of all claims pending on appeal is attached as Appendix A.

IV. STATUS OF AMENDMENTS

An Amendment After Final Action under 37 C.F.R. § 1.116 was filed on March 8, 2006. An Advisory Action mailed on March 24, 2006 stated that the proposed amendments were not entered because they raised new issues that would require further consideration and/or search.

V. SUMMARY OF CLAIMED SUBJECT MATTER

The present invention is defined by claims 1-17 and their equivalents, of which claims 1, 5, 9 and 13 are independent claims. Independent claim 9 is a means plus function claim as permitted by 35 U.S.C. § 112, paragraph 6. The following summary of

the claimed subject matter of independent claims 1, 5, 9 and 13 is set forth to comply with the requirements of 37 C.F.R. § 41.37(c)(1)(v), and is not intended to limit claims 1, 5, 9 and 13 in any way.

Claim 1 describes a method for upgrading a database to a current version format by chaining through intermediate versions (Specification, page 7, lines 2-4). The database can be any database for which a message-based upgrade protocol is used (Specification, page 7, lines 5-6). Update protocol messages from a previous version of the database are mapped into protocol messages of the next most recent version. These are mapped, in turn, to a more recent version until the message of the current version has been derived (Specification, page 7, lines 7-10). Figure 4 illustrates one exemplary embodiment of the method in processing steps 702, 714, 710, 716, 712, 718 and 708. A detailed description of the process illustrated in Figure 4 is contained in the Specification from page 16, line 23 to page 17, line 20.

Claim 5 describes an article of manufacture including a computer readable medium containing instructions that, when executed by a data processing system, cause the data processing system to perform a method for upgrading a database to a current version format by chaining through intermediate versions. Figure 4 illustrates one exemplary embodiment of the method in processing steps 702, 714, 710, 716, 712, 718 and 708. A detailed description of the process illustrated in Figure 4 is contained in the Specification from page 16, line 23 to page 17, line 20. Figure 1 illustrates an article of manufacture (Switch 50) including a computer readable medium (RAM 102 in Memory System 100) (Specification, page 9, line 25 to page 10, line 4). Instructions for upgrading the database (update messages) are generated from databases in RAM 102 (Specification,

page 12, lines 20-23). The instructions are executed by a processor (Processor 108) that executes code in Memory System 100 during the operation of Switch 50 (Specification, page 11, lines 9-11).

• Claim 9 is a means plus function claim as permitted by 35 U.S.C. § 112, paragraph 6. Claim 9 describes an apparatus for updating a message from a first version to an upgraded version by chaining through intermediate versions, including means (“first means”) for receiving an update message having a first version format, and means (“second means”) for repeatedly generating a revised update message having a next most recent version format based on the update message until a final update message having an upgraded version format is generated.

With respect to the first means, the Specification discloses that “[t]he process involves loading an image of the new release of operating code into ROM 104 and RAM 502. The process continues with creating new database structures in RAM 502, which conform to the specifications of the latest version, and updating the structures with update messages generated from the databases in RAM 102” (Specification, page 12, lines 18-23; Figure 3). With respect to the second means, the specification discloses that “[t]he update is performed by chaining mappings from one version to the next” (Specification, page 15, lines 15-16). As illustrated in Figure 1, all of the data flow between RAM 102 and RAM 502 is through Processor 108, Network Switching Device 110, Network switching device 510 and Processor 508. Therefore, the structures corresponding to the first means plus function clause of claim 9 includes RAM 102, Processor 108 and Network Switching Device 110. The structures corresponding to the second means plus

function clause of claim 9 include Network switching device 510, Processor 508 and RAM 502.

Claim 13 describes an apparatus including a network switching device (Figure 1: Controller Card 575 including Network Switching Device 510, Processor 508 and Memory System 500 including RAM 502) to receive an update message having a first version format (Specification, page 15, lines 13-15), and a controller card (Figure 1: Controller Card 75 including Network Switching Device 110, Processor 108 and Memory System 100 including RAM 102) to update a message from a first version to an upgraded version by chaining through intermediate versions (Specification, page 17, lines 4-20).

VI. GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL

- A. Claims 1, 9 and 13 stand rejected under 35 U.S.C. § 112, second paragraph, as being indefinite.
- B. Claims 1, 9 and 13 stand rejected under 35 U.S.C. § 101 as being directed to non-statutory subject matter. The Appellants note that in the Final Office Action (9/9/05 Office Action, p. 3, paragraph ii) the Examiner identified claims 1, 9 and 12 as rejected under 35 U.S.C. § 101. Claim 12 is a dependent claim. Appellants Appeal Brief is based on the assumption that the recital of claim 12 in the Final Office Action is a typographical error and that the Examiner intended to reject independent claim 13.
- C. Claims 5-8 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,148,329 of Meyer ("Meyer") in view of U.S. Patent No. 5,586,304 of Stupek et al. ("Stupek").

D. Claims 1-4 and 9-17 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Meyer in view of Stupek as applied to claims 5-8 and further in view of U.S. Patent No. 6,360,363 of Moser et al. ("Moser").

The Appellants note that the Examiner did not refer to the Moser reference in the initial statement of rejection of claims 1-4 and 9-17 in the Final Office Action (9/9/05 Office Action, p. 5, lines 10-13). Rather, the Examiner made a second reference to the Meyer reference. However, the text following the initial statement of rejection cites to the Moser reference repeatedly. The text of the Office Action repeats the Examiner's arguments for rejection from a previous Office Action (1/4/05 Office Action) in which the Moser reference was identified and cited in the initial statement of rejection of claims 1-4 and 9-17. Appellants' Appeal Brief is based on the assumption that the Examiner's second reference to the Meyer reference in the initial statement of rejection was intended to refer to the Moser reference.

VII. ARGUMENTS

A. Claims 1, 9 and 13 are not indefinite under 35 U.S.C. § 112, second paragraph.

1. The Examiner has failed to establish any grounds on which claim 1 is not compliant with the requirements of 35 U.S.C. § 112, second paragraph.

Chapter 35 U.S.C. § 112, second paragraph requires that "[t]he specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention." With regard to independent claim 1, the Examiner states:

Claim 1 recites the limitation “a method comprising” in claim [sic].
There is insufficient antecedent basis for this limitation in the claim.

(Final Office Action, 9/9/05, p. 2).

The Examiner thus characterizes the preamble of claim 1 as a limitation, and further purports that the preamble requires an antecedent basis. Appellants respectfully submit that the rejection is improper on both counts.

Appellants submit that the preamble “A method comprising” is not a limitation. A “method” is statutory subject matter within the boundaries set forth in 35 USC §101 which permits patents to be granted for “any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof.” The term process, as defined in 35 USC §100 means process, art or **method**, and includes a new use of a known process, machine, manufacture, composition of matter, or material (MPEP 706.03(a)) (emphasis added).

The word “comprising” is a transitional phrase. In a method claim, the transition “comprising” indicates that the claim is open ended and allows for additional steps (MPEP 2111.03, citing *Invitrogen Corp. Biocrest Mfg., L.P.*, 327 F.3d 1364, 1368, 66 USPQ2d 1631, 1634 (Fed. Cir. 2003)). Therefore, the term “comprising” is not a limitation.

Appellants further submit that the preamble phrase “A method” is the proper form for an independent method claim, such as claim 1. Claim 1 does not rely on a prior claim, and therefore requires no antecedent basis.

2. The Examiner has failed to establish any grounds on which claim 9 is not compliant with the requirements of 35 U.S.C. § 112, second paragraph.

Chapter 35 U.S.C. § 112, second paragraph requires that “[t]he specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.” With regard to claim 9, the Examiner states:

Claim 9 recites the limitation “an apparatus for updating a message from a first version to an upgraded version by chaining through intermediate versions comprising” in claim [sic]. There is insufficient antecedent basis for this limitation in the claim.”

(Final Office Action, 9/9/05, p. 2).

Here, the Examiner broadly characterizes a claim preamble as a limitation, without identifying what the limitation might be, and asserts that the preamble of this independent apparatus claim requires an antecedent basis. Appellants submit that the rejection is improper on both counts.

Appellants first submit that the preamble “An apparatus for updating a message from a first version to an upgraded version by chaining through intermediate versions comprising” is not a limitation.

An “apparatus” is statutory subject matter within the boundaries set forth in 35 USC §101 which permits patents to be granted for “any new and useful process, **machine**, manufacture, or composition of matter, or any new and useful improvement thereof.” (emphasis added). The use of “apparatus” in lieu of “machine” is well-accepted claim drafting practice.

If the body of a claim fully and intrinsically sets forth all of the limitations of the claimed invention, and the preamble merely states, for example, the purpose or intended use of the invention, rather than any distinct definition of any of the claimed inventions limitations, then the

preamble is not considered a limitation and is of no significance to claim construction.

(MPEP 2111.02, citing *Pitney Bowes, Inc. v. Hewlett-Packard Co.*, 182 F.3d 1298, 1305, 51 USPQ2d 1161, 1165 (Fed. Cir. 1999)).

Appellants submit that the body of claim 9 fully and intrinsically sets forth all of the limitations of the claimed invention, and that the phrase “for updating a message from a first version to an upgraded version by chaining through intermediate versions,” in the preamble of claim 9, is merely a statement reciting purpose or intended use. Therefore, it is not a limitation.

The word “comprising” is a transitional phrase. In a method claim, the transition “comprising” indicates that the claim is open ended and allows for additional steps (MPEP 2111.03, citing *Invitrogen Corp. Biocrest Mfg., L.P.*, 327 F.3d 1364, 1368, 66 USPQ2d 1631, 1634 (Fed. Cir. 2003)). Therefore, the term “comprising” is not a limitation.

Appellants further submit that the preamble phrase “An apparatus” is the proper form for an independent apparatus claim, such as claim 9. Claim 9 does not rely on a prior claim, and therefore requires no antecedent basis.

3. The Examiner has failed to establish any grounds on which claim 13 is not compliant with the requirements of 35 U.S.C. § 112, second paragraph.

Chapter 35 U.S.C. § 112, second paragraph requires that “[t]he specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.” With regard to claim 13, the Examiner states:

Claim 13 recites the limitation “an apparatus for updating a message from a first version to an upgraded version by chaining through intermediate versions comprising” in claim [sic]. There is insufficient antecedent basis for this limitation in the claim.”

(Final Office Action, 9/9/05, p. 2).

Here, the Examiner broadly characterizes a claim preamble as a limitation, without identifying what the limitation might be, and asserts that the preamble of this independent apparatus claim requires an antecedent basis. Appellants submit that the rejection is improper on both counts.

Appellants first submit that the preamble “An apparatus for updating a message from a first version to an upgraded version by chaining through intermediate versions comprising” is not a limitation.

An “apparatus” is statutory subject matter within the boundaries set forth in 35 USC §101 which permits patents to be granted for “any new and useful process, **machine**, manufacture, or composition of matter, or any new and useful improvement thereof.” (emphasis added). The use of “apparatus” in lieu of “machine” is well-accepted claim drafting practice.

If the body of a claim fully and intrinsically sets forth all of the limitations of the claimed invention, and the preamble merely states, for example, the purpose or intended use of the invention, rather than any distinct definition of any of the claimed inventions limitations, then the preamble is not considered a limitation and is of no significance to claim construction.

(MPEP 2111.02, citing *Pitney Bowes, Inc. v. Hewlett-Packard Co.*, 182 F.3d 1298, 1305, 51 USPQ2d 1161, 1165 (Fed. Cir. 1999)).

Appellants submit that the body of claim 13 fully and intrinsically sets forth all of the limitations of the claimed invention, and that the phrase “for updating a message from a first version to an upgraded version by chaining through intermediate versions,” in the preamble of claim 9, is merely a statement reciting purpose or intended use. Therefore, it is not a limitation.

The word “comprising” is a transitional phrase. In a method claim, the transition “comprising” indicates that the claim is open ended and allows for additional steps (MPEP 2111.03, citing *Invitrogen Corp. Biocrest Mfg., L.P.*, 327 F.3d 1364, 1368, 66 USPQ2d 1631, 1634 (Fed. Cir. 2003)). Therefore, the term “comprising” is not a limitation.

Appellants further submit that the preamble phrase “An apparatus” is the proper form for an independent apparatus claim, such as claim 13. Claim 13 does not rely on a prior claim, and therefore requires no antecedent basis.

B. Claims 1, 9 and 13 claim statutory subject matter under 35 U.S.C. § 101.

In the Final Office Action, the Examiner cited to the MPEP as follows:

A claim that requires one or more acts to be performed defines a process. However, not all processes are statutory under 35 U.S.C. 101. Schrader, 22 F.3d at 296, 30 USPQ2d at 1460. To be statutory, a claimed computer-related process must either: (A) result in a physical transformation outside the computer for which a practical application in the technological arts is either disclosed in the specification or would have been known to a skilled artisan, or (B) be limited to a practical application within the technological arts.(MPEP 2106 IV.B.2.(b))

(Final Office Action, 9/9/05, p. 3).

In rejecting claims 1, 9 and 13, the Examiner improperly reasoned that:

Claims 1, 9 and [13], in view of the above cited MPEP section, are not statutory because they merely recite a number of computing steps without producing any tangible result and/or being limited to a practical application within the technological arts.

(Final Office Action, 9/9/05, p. 3).

Despite the Examiner’s assertions, Appellants submit that claim 1 recites statutory subject matter because the claimed process is limited to a practical application within the technological arts. Applicants further submit that the Examiner’s argument with respect

to claims 9 and 13 are inapposite because claims 9 and 13 are apparatus claims, not process claims.

1. Claim 1 claims a statutory process under 35 U.S.C. § 101 because the claimed process produces a concrete, tangible and useful result.

Claim 1 recites:

A method, comprising:

updating a message from a first version to an upgraded version by chaining through intermediate versions, wherein updating comprises: receiving an update message having a first version format; and repeatedly generating a revised update message having a next most recent version format based on the update message **until a final update message having an upgraded version format is generated.**

(emphasis added).

Claim 1 is computer-related method claim. A “method” is statutory subject matter within the boundaries set forth in 35 USC §101 which permits patents to be granted for “any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof.” The term process, as defined in 35 USC §100 means process, art or **method**, and includes a new use of a known process, machine, manufacture, composition of matter, or material (MPEP 706.03(a)) (emphasis added).

To be statutory, a claimed computer-related process must either: (A) result in a physical transformation outside the computer for which a practical application in the technological arts is either disclosed in the specification or would have been known to a skilled artisan, or (B) **be limited to a practical application within the technological arts.**

(MPEP 2106 IV.B.2.(b)) (emphasis added).

A claim is limited to a practical application when the method, as claimed produces a concrete, tangible and useful result. *AT&T v. Excel Communications, Inc.*, 172 F.3d 1352, 1358 (Fed. Cir. 1999). Appellants submit that claim 1 is a statutory

process claim because the claimed method produces the useful, concrete and tangible result of an updated database.

2. The Examiner's rejection of claim 9 as a non-statutory computer-related process claim is inapposite because claim 9 is an apparatus claim.

Claim 9 recites:

An apparatus for updating a message from a first version to an upgraded version by chaining through intermediate versions comprising:
means for receiving an update message having a first version format;
and
means for repeatedly generating a revised update message having a next most recent version format based on the update message until a final update message having an upgraded version format is generated.

Claim 9 is a means plus function apparatus claim. An "apparatus" is statutory subject matter within the boundaries set forth in 35 USC §101 which permits patents to be granted for "any new and useful process, **machine**, manufacture, or composition of matter, or any new and useful improvement thereof." (emphasis added). The use of "apparatus" in lieu of "machine" is well-accepted claim drafting practice. A means plus function apparatus claim is permitted by 35 U.S.C. § 112, sixth paragraph. Therefore, the Examiner's rejection of claim 9 on the grounds that claim 9 is a process claim is simply erroneous.

3. The Examiner's rejection of claim 13 as a non-statutory computer-related process claim is inapposite because claim 13 is an apparatus claim.

Claim 13 recites:

An apparatus, comprising:
a network switching device to receive an update message having a first version format; and,

a controller card to update a message from a first version to an upgraded version by chaining through intermediate versions, the controller card to repeatedly generate a revised update message having a next most recent version format based on the update message until a final update message having an upgraded version format is generated.

Claim 13 is an apparatus claim. An “apparatus” is statutory subject matter within the boundaries set forth in 35 USC §101 which permits patents to be granted for “any new and useful process, **machine**, manufacture, or composition of matter, or any new and useful improvement thereof.” (emphasis added). The use of “apparatus” in lieu of “machine” is well-accepted claim drafting practice. Therefore, the Examiner’s rejection of claim 13 on the grounds that claim 13 is a process claim is simply erroneous.

C. Claim 5 is patentable under 35 U.S.C. § 103(a) over Meyer in view of Stupek.

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or combine the reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitation. *In re Vaeck*, 947 F.2d 488 (Fed. Cir. 1991); MPEP 2143.

1. The Examiner has failed to provide a motivation to combine the cited references.

Claim 5 recites:

An article of manufacture comprising a computer readable medium having instructions stored thereon, which when executed by a data processing system, causes the data-processing system to perform a method, comprising:
receiving an update message having a first version format; and

generating repeatedly a revised update message having a next most recent version format based on the update message until a final update message having an upgraded version format is generated.

(emphasis added).

In the Final Office Action, the Examiner stated that:

It would have been obvious to a person of ordinary [skill] in the art at the time the invention was made **to modify the combined teachings of Meyer and Stupek** with generating repeatedly a revised update message having a next most recent version format based on the update message until a final update message having an upgraded version format is generated. Such modification would allow the teachings of Meyer to **improve the accuracy of the method and apparatus for upgrading a database** in a redundant environment by release chaining . . . (see col. 2, lines 42-44).

(Final Office Action, 9/9/05, page 4, lines 18-24) (emphasis added).

Appellants note that the Examiner states that it would have been obvious to modify the combined teachings of Meyer and Stupek. The Examiner simply assumes the combination of Meyer and Stupek and then falls back on the level of skill in the art to provide a missing limitation. The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. *In re Mills*, 916 F.2d 680 (Fed. Cir. 1990); MPEP 2143.01. The Examiner fails to point out any suggestion in Meyer for a combination with Stupek or any Suggestion in Stupek for a combination with Myer. Appellants submit that the only source for the Examiner's purported modification is impermissible hindsight based on the disclosure of the present application.

Furthermore, the level of skill in the art cannot be relied on to provide the suggestion to combine or modify references. *Al-Site Corp. v. VSI Int'l Inc.*, 174 F.3d 1308; MPEP 2143.01. The Examiner asserts that one of ordinary skill in the art would be motivated to modify the combined teachings of Meyer and Stupek with the missing

limitation to “improve the accuracy of the method and apparatus for upgrading a database . . . by release chaining.” Such a broad and vague generalization cannot serve as a basis for a motivation to modify references.

The Examiner is required to provide a specific understanding or principle within the knowledge of the skilled artisan that would have provided the motivation to modify the reference in the manner purported by the Examiner. *In re Kotzab*, 217 F.3d 1365, 1371 (Fed. Cir. 2000); MPEP 2143.01. The Examiner has failed to provide the specific understanding or principle within the knowledge of the skilled artisan that would have provided the motivation to modify the teachings of Meyer and Stupek in the purported manner. Therefore, the Examiner has not met his burden to show a motivation for the purported modification and has not established a *prima facie* case of obviousness.

2. Even if the cited references could be combined, the combination does not teach or suggest every limitation of claim 5.

Claim 5 recites:

An article of manufacture comprising a computer readable medium having instructions stored thereon, which when executed by a data processing system, causes the data-processing system to perform a method, comprising:

receiving an update message having a first version format; and
generating repeatedly a revised update message having a next most recent version format based on the update message until a final update message having an upgraded version format is generated.

(emphasis added).

In the Final Office Action, the Examiner stated that “Meyer does not explicitly disclose repeated generation of a revised update message having a next most recent version format based on the update message until a final update message having an

upgraded version format is generated.” (Office Action, 9/9/05, page 4, lines 10-12). The Examiner further stated that:

Stupek discloses a method for use in upgrading a resource of a computer from an existing version of the resource to a later version of the resource (see col. 1, lines 56 to col. 2, line 41). Further, in column 9, line 1 to column 10, line 6, Stupek discloses the upgrade installer builds the selected upgrade packages and installation instructions into a job, which is transferred into a staging area, an agent client is then notified that a job has been placed in the staging area and the agent installs the packages in the job according to the installation instructions.

(Office Action, 9/9/05, page 4, lines 12-18).

The Examiner makes an omnibus citation to Stupek (127 lines over two pages), yet in his summary is unable to state how the cited passage teaches or suggests “generating repeatedly a revised update message having a next most recent version format based on the update message until a final update message having an upgraded version format is generated,” as recited in claim 5. In fact, the summary of the citation offered by the Examiner is a *non sequitur* with respect to the subject limitation of claim 5. Stupek teaches the upgrading of a program to a **newest** version either automatically or manually by displaying to the user the difference between an installed version of the program and the newest version of the program. This is illustrated in Figure 9 of Stupek, which shows on the right hand side of box 51 the “Installed Version 2.30” and the “**Newest** Version 2.40 – 11/5/1993” (Stupek, Figure 9) (emphasis added). As such, there is no disclosure of “repeated generation of a revised update message having a next most recent version format based on the update message until a final update message having an upgraded version format is generated,” as recited in claim 5. Appellants submit, therefore, that Meyer and Stupek, either alone or in combination, do not teach or suggest the subject limitation of claim 5.

3. Even if the cited references could be combined, the proposed modification would change the principle of operation of the references and render the references unsuitable for their intended purposes.

If the proposed modification or combination of the prior art would change the principle of operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims *prima facie* obvious. *In re Ratti*, 270 F.2d 810, 123 USPQ 349 (CCPA 1959). Also, if the proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification. *In re Gordon*, 733 F.2d 900 (Fed. Cir. 1984)

Both Meyer and Stupek are directed to updating one or more prior versions of data or computer resources **directly** to a current version without chaining through intermediate releases. (Meyer, col. 4, lines 42-44; Stupek, col. 1, lines 56-62). Since Meyer and Stupek both rely on the principle of direct updating from one or more prior versions of data or software to a current version to avoid intermediate chaining, modifying either Meyer or Stupek to implement release chaining through intermediate versions would alter the basic principles of operation of the references. Furthermore, the proposed modification would render the references unsatisfactory for their intended purposes because release chaining in the systems of Meyer and Stupek would slow the operations of Meyer and Stupek.

Therefore, because the proposed modification would alter the principle of operation of operation of the references and render the references unsuitable for their

intended purpose, the teachings of the references are not sufficient to render claim 5 *prima facie* obvious and there is no suggestion or motivation to make the proposed modification.

D. Claim 1 is patentable under 35 U.S.C. § 103(a) over Meyer in view of Stupek and further in view of Moser.

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or combine the reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitation. *In re Vaeck*, 947 F.2d 488 (Fed. Cir. 1991); MPEP 2143.

1. The Examiner has failed to provide a motivation to combine the cited references.

Claim 1 recites:

A method comprising:

updating a message from a first version to an upgraded version by chaining through intermediate versions, wherein updating comprises:

receiving an update message having a first version format; and
repeatedly generating a revised update message having a next most recent version format based on the update message until a final update message having an upgraded version format is generated.

(emphasis added).

In the Final Office Action, the Examiner stated that:

It would have been obvious to a person of ordinary [skill] in the art at the time the invention was made **to modify the combined teachings of Meyer and Stupek** with repeatedly generating a revised update message having a next most recent version format based on the update message until a final update message having an upgraded version format is generated. Such modification would allow the teachings of Meyer to **improve the accuracy of the method and apparatus for upgrading a database in a redundant environment by release chaining, and to provide automatically determined [sic] the availability of upgrades to resources on a computer system** (see [Stupek,] col. 2, lines 42-44).

(Final Office Action, 9/9/05, page 6, lines 5-13) (emphasis added).

Appellants note that the Examiner states that it would have been obvious to a person of ordinary skill in the art to modify the combined teachings of Meyer and Stupek. The Examiner simply assumes the combination of Meyer and Stupek and then falls back on the level of skill in the art to provide a missing limitation. The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. *In re Mills*, 916 F.2d 680 (Fed. Cir. 1990); MPEP 2143.01. The Examiner fails to point out any suggestion in Meyer for a combination with Stupek, or any suggestion in Stupek for a combination with Myer. Appellants submit that the only source for the Examiner's purported modification is impermissible hindsight based on the disclosure of the present application.

Furthermore, the level of skill in the art cannot be relied on to provide the suggestion to combine or modify references. *Al-Site Corp. v. VSI Int'l Inc.*, 174 F.3d 1308; MPEP 2143.01. The Examiner asserts that one of ordinary skill in the art would be motivated to modify the combined teachings of Meyer and Stupek with the missing limitation to first "improve the accuracy of the method and apparatus for upgrading a database . . . by release chaining," and second "to provide automatically determined the

availability of upgrades to resources on a computer system.” Such a broad and vague generalization as “improve the accuracy” cannot serve as a basis for a motivation to modify references. Furthermore, the Examiner provides no explanation of how the purported modification of release chaining would operate “to provide automatically determined the availability of upgrades to resources on a computer system.” The Examiner has simply parroted a stated objective of the Stupek invention with no supporting rationale.

The Examiner is required to provide a specific understanding or principle within the knowledge of the skilled artisan that would have provided the motivation to modify the reference in the manner purported by the Examiner. *In re Kotzab*, 217 F.3d 1365, 1371 (Fed Cir. 2000); MPEP 2143.01. The Examiner has failed to provide the specific understanding or principle within the knowledge of the skilled artisan that would have provided the motivation to modify the teachings of Meyer and Stupek in the purported manner. Therefore, the Examiner has not met his burden to show a motivation for the purported modification and has not established a *prima facie* case of obviousness.

In the Final Office Action, the Examiner also stated that:

It would have been obvious to a person of ordinary [skill] in the art at the time the invention was made **to modify the combined teachings of Meyer, Stupek and Moser** with updating a message from a first version to an upgraded version by chaining through intermediate versions. Such modification would allow the teachings of Meyer, Stupek and Moser **to provide a mechanism that can upgrade a computer program without requiring that the normal operation of the computer program be suspended** (see Moser col. 3, lines 32-36).

(Final Office Action, 9/9/05, page 6, lines 16-21) (emphasis added).

Appellants note that the Examiner states that it would have been obvious to a person of ordinary skill in the art to modify the combined teachings of Meyer, Stupek and Moser. The Examiner simply assumes the combination of Meyer, Stupek and Moser and again falls back on the level of skill in the art to provide a missing limitation. The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. *In re Mills*, 916 F.2d 680 (Fed. Cir. 1990); MPEP 2143.01. The Examiner fails to point out any suggestion in Meyer for a combination with Stupek or Moser, any suggestion in Stupek for a combination with Meyer or Moser, or any suggestion in Moser for a combination with Meyer or Stupek. Appellants submit that the only source for the Examiner's purported modification is impermissible hindsight based on the disclosure of the present application.

Furthermore, the level of skill in the art cannot be relied on to provide the suggestion to combine or modify references. *Al-Site Corp. v. VSI Int'l Inc.*, 174 F.3d 1308; MPEP 2143.01. The Examiner asserts that one of ordinary skill in the art would be motivated to modify the combined teachings of Meyer, Stupek and Moser with the missing limitation to "to provide a mechanism that can upgrade a computer program without requiring that the normal operation of the computer program be suspended." The Examiner provides no explanation of how the purported modification of release chaining would operate "to provide a mechanism that can upgrade a computer program without requiring that the normal operation of the computer program be suspended." The Examiner has simply parroted a stated objective of the Moser invention with no supporting rationale.

The Examiner is required to provide a specific understanding or principle within the knowledge of the skilled artisan that would have provided the motivation to modify the reference in the manner purported by the Examiner. *In re Kotzab*, 217 F.3d 1365, 1371 (Fed. Cir. 2000); MPEP 2143.01. The Examiner has failed to provide the specific understanding or principle within the knowledge of the skilled artisan that would have provided the motivation to modify the teachings of Meyer, Stupek and Moser in the purported manner. Therefore, the Examiner has not met his burden to show a motivation for the purported modification and has not established a *prima facie* case of obviousness.

2. Even if the cited references could be combined, the combination does not teach or suggest every limitation of claim 1.

Claim 1 recites:

A method comprising:
updating a message from a first version to an upgraded version by chaining through intermediate versions, wherein updating comprises:
receiving an update message having a first version format; and
repeatedly generating a revised update message having a next most recent version format based on the update message until a final update message having an upgraded version format is generated.

(emphasis added).

In the Final Office Action, the Examiner stated that “Meyer does not explicitly disclose repeated generation of a revised update message having a next most recent version format based on the update message until a final update message having an upgraded version format is generated.” (Office Action, 9/9/05, page 5, lines 20-22). The Examiner further stated that:

Stupek discloses a method for use in upgrading a resource of a computer from an existing version of the resource to a later version of the resource (see col. 1, lines 56 to col. 2, line 41). Further, in column 9, line 1 to column 10, line 6, Stupek discloses the upgrade installer builds the selected upgrade packages and installation instructions into a job, which is transferred into a staging area, an agent client is then notified that a job has been placed in the staging area and the agent installs the packages in the job according to the installation instructions.

(Office Action, 9/9/05, page 5, line 23 to page 6, line 5).

The Examiner makes an omnibus citation to Stupek (127 lines over two pages), yet in his summary is unable to state how the cited passage teaches or suggests “generating repeatedly a revised update message having a next most recent version format based on the update message until a final update message having an upgraded version format is generated,” as recited in claim 1. In fact, the summary of the citation offered by the Examiner is a *non sequitur* with respect to the subject limitation of claim 5. Stupek teaches the upgrading of a program to a **newest** version either automatically or manually by displaying to the user the difference between an installed version of the program and the newest version of the program. This is illustrated in Figure 9 of Stupek, which shows on the right hand side of box 51 the “Installed Version 2.30” and the “**Newest** Version 2.40 – 11/5/1993” (Stupek, Figure 9) (emphasis added). As such, there is no disclosure of “repeated generation of a revised update message having a next most recent version format based on the update message until a final update message having an upgraded version format is generated,” as recited in claim 5. Appellants submit, therefore, that Meyer and Stupek, either alone or in combination, do not teach or suggest the subject limitation of claim 1.

The Examiner also erroneously asserted in the Final Office Action that:

While Meyer and Stupek disclose the claimed subject matter except the claimed updating a message from a first version to an upgraded version by chaining through intermediate versions. However, Moser discloses an intermediate program P' that contains an intermediate version of each of the program modules to be upgraded, the intermediate version of a program module contains both the old version used in P and the new version used in P' (see Moser col. 3, lines 9-21).

(Office Action, 9/9/06, page 6, lines 11-16).

Appellants incorporate by reference Appellants arguments above with respect to the combination of Meyer and Stupek and submit that claim 1 is patentable over Meyer, Stupek and Moser for at least the same reason that claim 1 is patentable over the combination of Meyer and Stupek alone. With respect to Moser, Appellants submit that the Examiner mischaracterizes the teachings of Moser. Moser discloses combining an old version of a program with a new version of the program in a temporary intermediate version of the program that contains both the old version of the program and the new version of the program. (Moser, col. 3, lines 12-14). That is, the updated version of the program in Moser already exists when the intermediate version is created.

Combining an existing updated version of a program with an old version of the program to create an intermediate version of the program is not the same as "updating a message from a first version to an upgraded version by chaining through intermediate versions" as recited in claim 1. Appellants submit, therefore, that Meyer, Stupek and Moser, either alone or in combination, do not teach or suggest the limitation "updating a message from a first version to an upgraded version by chaining through intermediate versions" as recited in claim 1.

3. Even if the cited references could be combined, the proposed modification would change the principle of operation of the references and render the references unsuitable for their intended purposes.

If the proposed modification or combination of the prior art would change the principle of operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims *prima facie* obvious. *In re Ratti*, 270 F.2d 810, 123 USPQ 349 (CCPA 1959). Also, if the proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification. *In re Gordon*, 733 F.2d 900 (Fed. Cir. 1984)

Both Meyer and Stupek are directed to updating a prior version of data or a computer resource **directly** to a current version without chaining through intermediate releases. (Meyer, col. 4, lines 42-44; Stupek, col. 1, lines 56-62). Since Meyer and Stupek both rely on the principle of direct updating from one or more prior versions of data or software to a current version, modifying either Meyer or Stupek to implement release chaining through intermediate versions would alter the basic principles of operation of the references. In particular, one of ordinary skill in the art would not be motivated to modify Meyer in the manner purported by the Examiner. The object of the teachings in Meyer is to redeliver a stored message to a subscriber in a current format and to do so in a manner that **speeds up the redelivery function** (Meyer, col. 1, lines 35-40; col. 2, lines 35-47; col. 8, line 62). One of skill in the art, facing the problems confronting the inventor of Meyer, would not be motivated to modify Meyer in the

manner purported by the examiner because the repeated generation of a revised update message having a next most recent version would **slow down** the redelivery function, **contrary to the teachings of Meyer**, and render the invention of Meyer unsatisfactory for its intended purpose. Therefore, because the proposed modification would alter the principle of operation of operation of the reference(s) and render the reference(s) unsuitable for their intended purpose, the teachings of the references are not sufficient to render claim 1 *prima facie* obvious and there is no suggestion or motivation to make the proposed modification.

E. Claim 9 is patentable under 35 U.S.C. § 103(a) over Meyer in view of Stupek and further in view of Moser.

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or combine the reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitation. *In re Vaeck*, 947 F.2d 488 (Fed. Cir. 1991); MPEP 2143.

1. The Examiner has failed to provide a motivation to combine the cited references.

Claim 9 recites:

An apparatus for updating a message from a first version to an upgraded version by chaining through intermediate versions comprising:
means for receiving an update message having a first version format;
and

means for repeatedly generating a revised update message having a next most recent version format based on the update message until a final update message having an upgraded version format is generated.

(emphasis added).

In the Final Office Action, the Examiner stated that:

It would have been obvious to a person of ordinary [skill] in the art at the time the invention was made **to modify the combined teachings of Meyer and Stupek** with means for repeatedly generating a revised update message having a next most recent version format based on the update message until a final update message having an upgraded version format is generated. Such modification would allow the teachings of Meyer to **improve the accuracy of the method and apparatus for upgrading a database** in a redundant environment **by release chaining, and to provide automatically determined [sic] the availability of upgrades to resources on a computer system** (see [Stupek,] col. 2, lines 42-44).

(Final Office Action, 9/9/05, page 7, line 21 to page 8, line 2) (emphasis added).

Appellants note that the Examiner states that it would have been obvious to a person of ordinary skill in the art to modify the combined teachings of Meyer and Stupek. The Examiner simply assumes the combination of Meyer and Stupek and then falls back on the level of skill in the art to provide a missing limitation. The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. *In re Mills*, 916 F.2d 680 (Fed. Cir. 1990); MPEP 2143.01. The Examiner fails to point out any suggestion in Meyer for a combination with Stupek, or any suggestion in Stupek for a combination with Myer. Appellants submit that the only source for the Examiner's purported modification is impermissible hindsight based on the disclosure of the present application.

Furthermore, the level of skill in the art cannot be relied on to provide the suggestion to combine or modify references. *Al-Site Corp. v. VSI Int'l Inc.*, 174 F.3d 1308; MPEP 2143.01. The Examiner asserts that one of ordinary skill in the art would be motivated to modify the combined teachings of Meyer and Stupek with the missing limitation to first “improve the accuracy of the method and apparatus for upgrading a database . . . by release chaining,” and second “to provide automatically determined the availability of upgrades to resources on a computer system.” Such a broad and vague generalization as “improve the accuracy” cannot serve as a basis for a motivation to modify references. Furthermore, the Examiner provides no explanation of how the purported modification of release chaining would operate “to provide automatically determined the availability of upgrades to resources on a computer system.” The Examiner has simply parroted a stated objective of the Stupek invention with no supporting rationale.

The Examiner is required to provide a specific understanding or principle within the knowledge of the skilled artisan that would have provided the motivation to modify the reference in the manner purported by the Examiner. *In re Kotzab*, 217 F.3d 1365, 1371 (Fed Cir. 2000); MPEP 2143.01. The Examiner has failed to provide the specific understanding or principle within the knowledge of the skilled artisan that would have provided the motivation to modify the teachings of Meyer and Stupek in the purported manner. Therefore, the Examiner has not met his burden to show a motivation for the purported modification and has not established a *prima facie* case of obviousness.

In the Final Office Action, the Examiner also stated that:

It would have been obvious to a person of ordinary [skill] in the art at the time the invention was made **to modify the combined teachings of**

Meyer, Stupek and Moser with updating a message from a first version to an upgraded version by chaining through intermediate versions. Such modification would allow the teachings of Meyer, Stupek and Moser **to provide a mechanism that can upgrade a computer program without requiring that the normal operation of the computer program be suspended** (see Moser col. 3, lines 32-36).

(Final Office Action, 9/9/05, page 8, lines 7-12) (emphasis added).

Appellants note that the Examiner states that it would have been obvious to a person of ordinary skill in the art to modify the combined teachings of Meyer, Stupek and Moser. The Examiner simply assumes the combination of Meyer, Stupek and Moser and again falls back on the level of skill in the art to provide a missing limitation. The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. *In re Mills*, 916 F.2d 680 (Fed. Cir. 1990); MPEP 2143.01. The Examiner fails to point out any suggestion in Meyer for a combination with Stupek or Moser, any suggestion in Stupek for a combination with Meyer or Moser, or any suggestion in Moser for a combination with Meyer or Stupek. Appellants submit that the only source for the Examiner's purported modification is impermissible hindsight based on the disclosure of the present application.

Furthermore, the level of skill in the art cannot be relied on to provide the suggestion to combine or modify references. *Al-Site Corp. v. VSI Int'l Inc.*, 174 F.3d 1308; MPEP 2143.01. The Examiner asserts that one of ordinary skill in the art would be motivated to modify the combined teachings of Meyer, Stupek and Moser with the missing limitation to "to provide a mechanism that can upgrade a computer program without requiring that the normal operation of the computer program be suspended." The

Examiner provides no explanation of how the purported modification of release chaining would operate “to provide a mechanism that can upgrade a computer program without requiring that the normal operation of the computer program be suspended.” The Examiner has simply parroted a stated objective of the Moser invention with no supporting rationale.

The Examiner is required to provide a specific understanding or principle within the knowledge of the skilled artisan that would have provided the motivation to modify the reference in the manner purported by the Examiner. *In re Kotzab*, 217 F.3d 1365, 1371 (Fed Cir. 2000); MPEP 2143.01. The Examiner has failed to provide the specific understanding or principle within the knowledge of the skilled artisan that would have provided the motivation to modify the teachings of Meyer, Stupek and Moser in the purported manner. Therefore, the Examiner has not met his burden to show a motivation for the purported modification and has not established a *prima facie* case of obviousness.

2. Even if the cited references could be combined, the combination does not teach or suggest every limitation of claim 9.

Claim 9 recites:

An apparatus for updating a message from a first version to an upgraded version by chaining through intermediate versions comprising:

means for receiving an update message having a first version format;
and

means for **repeatedly generating a revised update message having a next most recent version format based on the update message until a final update message having an upgraded version format is generated.**

(emphasis added).

In the Final Office Action, the Examiner stated that “Meyer does not explicitly disclose repeated generation of a revised update message having a next most recent version format based on the update message until a final update message having an upgraded version format is generated.” (Office Action, 9/9/05, page 5, lines 20-22). The Examiner further stated that:

Stupek discloses a method for use in upgrading a resource of a computer from an existing version of the resource to a later version of the resource (see col. 1, lines 56 to col. 2, line 41). Further, in column 9, line 1 to column 10, line 6, Stupek discloses the upgrade installer builds the selected upgrade packages and installation instructions into a job, which is transferred into a staging area, an agent client is then notified that a job has been placed in the staging area and the agent installs the packages in the job according to the installation instructions.

(Office Action, 9/9/05, page 7, lines 13-21).

The Examiner makes an omnibus citation to Stupek (127 lines over two pages), yet in his summary is unable to state how the cited passage teaches or suggests “generating repeatedly a revised update message having a next most recent version format based on the update message until a final update message having an upgraded version format is generated,” as recited in claim 1. In fact, the summary of the citation offered by the Examiner is a *non sequitur* with respect to the subject limitation of claim 5. Stupek teaches the upgrading of a program to a **newest** version either automatically or manually by displaying to the user the difference between an installed version of the program and the newest version of the program. This is illustrated in Figure 9 of Stupek, which shows on the right hand side of box 51 the “Installed Version 2.30” and the “**Newest** Version 2.40 – 11/5/1993” (Stupek, Figure 9) (emphasis added). As such, there is no disclosure of “repeated generation of a revised update message having a next most recent version format based on the update message until a final update message having an

upgraded version format is generated,” as recited in claim 5. Appellants submit, therefore, that Meyer and Stupek, either alone or in combination, do not teach or suggest the subject limitation of claim 9.

The Examiner also erroneously asserted in the Final Office Action that:

While Meyer and Stupek disclose the claimed subject matter except the claimed updating a message from a first version to an upgraded version by chaining through intermediate versions. However, Moser discloses an intermediate program P' that contains an intermediate version of each of the program modules to be upgraded, the intermediate version of a program module contains both the old version used in P and the new version used in P' (see Moser col. 3, lines 9-21).

(Office Action, 9/9/06, page 8, lines 3-7).

Appellants incorporate by reference Appellants arguments above with respect to the combination of Meyer and Stupek and submit that claim 9 is patentable over Meyer, Stupek and Moser for at least the same reason that claim 9 is patentable over the combination of Meyer and Stupek alone. With respect to Moser, Appellants submit that the Examiner mischaracterizes the teachings of Moser. Moser discloses combining an old version of a program with a new version of the program in a temporary intermediate version of the program that contains both the old version of the program and the new version of the program. (Moser, col. 3, lines 12-14). That is, the updated version of the program in Moser already exists when the intermediate version is created.

Combining an existing updated version of a program with an old version of the program to create an intermediate version of the program is not the same as “updating a message from a first version to an upgraded version by chaining through intermediate versions” as recited in claim 9. Appellants submit, therefore, that Meyer, Stupek and

Moser, either alone or in combination, do not teach or suggest the limitation “updating a message from a first version to an upgraded version by chaining through intermediate versions” as recited in claim 9.

3. Even if the cited references could be combined, the proposed modification would change the principle of operation of the references and render the references unsuitable for their intended purposes.

If the proposed modification or combination of the prior art would change the principle of operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims *prima facie* obvious. *In re Ratti*, 270 F.2d 810, 123 USPQ 349 (CCPA 1959). Also, if the proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification. *In re Gordon*, 733 F.2d 900 (Fed. Cir. 1984)

Both Meyer and Stupek are directed to updating a prior version of data or a computer resource **directly** to a current version without chaining through intermediate releases. (Meyer, col. 4, lines 42-44; Stupek, col. 1, lines 56-62). Since Meyer and Stupek both rely on the principle of direct updating from one or more prior versions of data or software to a current version, modifying either Meyer or Stupek to implement release chaining through intermediate versions would alter the basic principles of operation of the references. In particular, one of ordinary skill in the art would not be motivated to modify Meyer in the manner purported by the Examiner. The object of the teachings in Meyer is to redeliver a stored message to a subscriber in a current format and

to do so in a manner that **speeds up the redelivery function** (Meyer, col. 1, lines 35-40; col. 2, lines 35-47; col. 8, line 62). One of skill in the art, facing the problems confronting the inventor of Meyer, would not be motivated to modify Meyer in the manner purported by the examiner because updating a message from a first version to an upgraded version by chaining through intermediate versions would **slow down** the redelivery function, **contrary to the teachings of Meyer**, and render the invention of Meyer unsatisfactory for its intended purpose. Therefore, because the proposed modification would alter the principle of operation of operation of the reference(s) and render the reference(s) unsuitable for their intended purpose, the teachings of the references are not sufficient to render claim 1 *prima facie* obvious and there is no suggestion or motivation to make the proposed modification.

F. Claim 13 is patentable under 35 U.S.C. § 103(a) over Meyer in view of Stupek and further in view of Moser.

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or combine the reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitation. *In re Vaeck*, 947 F.2d 488 (Fed. Cir. 1991); MPEP 2143.

1. The Examiner has failed to provide a motivation to combine the cited references.

Claim 13 recites:

An apparatus comprising:

a network switching device to receive an update message having a first version format; and,

a controller card to update a message from a first version to an upgraded version by chaining through intermediate versions, the controller card **to repeatedly generate a revised update message having a next most recent version format based on the update message until a final update message having an upgraded version format is generated.**

(emphasis added).

In the Final Office Action, the Examiner stated that:

It would have been obvious to a person of ordinary [skill] in the art at the time the invention was made **to modify the combined teachings of Meyer and Stupek** with means for repeatedly generating a revised update message having a next most recent version format based on the update message until a final update message having an upgraded version format is generated. Such modification would allow the teachings of Meyer **to improve the accuracy of the method and apparatus for upgrading a database** in a redundant environment **by release chaining, and to provide automatically determined [sic] the availability of upgrades to resources on a computer system** (see [Stupek,] col. 2, lines 42-44).

(Final Office Action, 9/9/05, page 9, lines 4-10) (emphasis added).

Appellants note that the Examiner states that it would have been obvious to a person of ordinary skill in the art to modify the combined teachings of Meyer and Stupek. The Examiner simply assumes the combination of Meyer and Stupek and then falls back on the level of skill in the art to provide a missing limitation. The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. *In re Mills*, 916 F.2d 680 (Fed. Cir. 1990); MPEP 2143.01. The Examiner fails to point out any suggestion in Meyer for a combination with Stupek, or any suggestion in Stupek for a

combination with Myer. Appellants submit that the only source for the Examiner's purported modification is impermissible hindsight based on the disclosure of the present application.

Furthermore, the level of skill in the art cannot be relied on to provide the suggestion to combine or modify references. *Al-Site Corp. v. VSI Int'l Inc.*, 174 F.3d 1308; MPEP 2143.01. The Examiner asserts that one of ordinary skill in the art would be motivated to modify the combined teachings of Meyer and Stupek with the missing limitation to first "improve the accuracy of the method and apparatus for upgrading a database . . . by release chaining," and second "to provide automatically determined the availability of upgrades to resources on a computer system." Such a broad and vague generalization as "improve the accuracy" cannot serve as a basis for a motivation to modify references. Furthermore, the Examiner provides no explanation of how the purported modification of release chaining would operate "to provide automatically determined the availability of upgrades to resources on a computer system." The Examiner has simply parroted a stated objective of the Stupek invention with no supporting rationale.

The Examiner is required to provide a specific understanding or principle within the knowledge of the skilled artisan that would have provided the motivation to modify the reference in the manner purported by the Examiner. *In re Kotzab*, 217 F.3d 1365, 1371 (Fed Cir. 2000); MPEP 2143.01. The Examiner has failed to provide the specific understanding or principle within the knowledge of the skilled artisan that would have provided the motivation to modify the teachings of Meyer and Stupek in the purported

manner. Therefore, the Examiner has not met his burden to show a motivation for the purported modification and has not established a *prima facie* case of obviousness.

2. Even if the cited references could be combined, the combination does not teach or suggest every limitation of claim 13.

Claim 13 recites:

An apparatus comprising:

a network switching device to receive an update message having a first version format; and,

a controller card to update a message from a first version to an upgraded version by chaining through intermediate versions, the controller card **to repeatedly generate a revised update message having a next most recent version format based on the update message until a final update message having an upgraded version format is generated.**

(emphasis added).

In the Final Office Action, the Examiner stated that “Meyer does not explicitly disclose repeated generation of a revised update message having a next most recent version format based on the update message until a final update message having an upgraded version format is generated.” (Office Action, 9/9/05, page 8, lines 22-25). The Examiner further stated that:

Stupek discloses a method for use in upgrading a resource of a computer from an existing version of the resource to a later version of the resource (see col. 1, lines 56 to col. 2, line 41). Further, in column 9, line 1 to column 10, line 6, Stupek discloses the upgrade installer builds the selected upgrade packages and installation instructions into a job, which is transferred into a staging area, an agent client is then notified that a job has been placed in the staging area and the agent installs the packages in the job according to the installation instructions.

(Office Action, 9/9/05, page 8, line 25 to page 9, line 4).

The Examiner makes an omnibus citation to Stupek (127 lines over two pages), yet in his summary is unable to state how the cited passage teaches or suggests “generating repeatedly a revised update message having a next most recent version format based on the update message until a final update message having an upgraded version format is generated,” as recited in claim 1. In fact, the summary of the citation offered by the Examiner is a *non sequitur* with respect to the subject limitation of claim 5. Stupek teaches the upgrading of a program to a **newest** version either automatically or manually by displaying to the user the difference between an installed version of the program and the newest version of the program. This is illustrated in Figure 9 of Stupek, which shows on the right hand side of box 51 the “Installed Version 2.30” and the “**Newest** Version 2.40 – 11/5/1993” (Stupek, Figure 9) (emphasis added). As such, there is no disclosure of “repeated generation of a revised update message having a next most recent version format based on the update message until a final update message having an upgraded version format is generated,” as recited in claim 5. Appellants submit, therefore, that Meyer and Stupek, either alone or in combination, do not teach or suggest the subject limitation of claim 13.

3. Even if the cited references could be combined, the proposed modification would change the principle of operation of the references and render the references unsuitable for their intended purposes.

If the proposed modification or combination of the prior art would change the principle of operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims *prima facie* obvious. *In re Ratti*, 270

F.2d 810, 123 USPQ 349 (CCPA 1959). Also, if the proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification. *In re Gordon*, 733 F.2d 900 (Fed. Cir. 1984)

Both Meyer and Stupek are directed to updating a prior version of data or a computer resource **directly** to a current version without chaining through intermediate releases. (Meyer, col. 4, lines 42-44; Stupek, col. 1, lines 56-62). Since Meyer and Stupek both rely on the principle of direct updating from one or more prior versions of data or software to a current version, modifying either Meyer or Stupek to implement release chaining through intermediate versions would alter the basic principles of operation of the references. In particular, one of ordinary skill in the art would not be motivated to modify Meyer in the manner purported by the Examiner. The object of the teachings in Meyer is to redeliver a stored message to a subscriber in a current format and to do so in a manner that **speeds up the redelivery function** (Meyer, col. 1, lines 35-40; col. 2, lines 35-47; col. 8, line 62). One of skill in the art, facing the problems confronting the inventor of Meyer, would not be motivated to modify Meyer in the manner purported by the examiner because repeated generation of a revised update message having a next most recent version would **slow down** the redelivery function, **contrary to the teachings of Meyer**, and render the invention of Meyer unsatisfactory for its intended purpose. Therefore, because the proposed modification would alter the principle of operation of operation of the reference(s) and render the reference(s) unsuitable for their intended purpose, the teachings of the references are not sufficient to

render claim 1 *prima facie* obvious and there is no suggestion or motivation to make the proposed modification.

VIII. CONCLUSION

For the foregoing reasons, Appellants respectfully submit 1) that the rejections of claims 1, 9 and 13 under 35 U.S.C. § 112, second paragraph have been overcome, 2) that the rejections of claims 1, 9 and 13 under 35 U.S.C. § 101 have been overcome, 3) that the rejections of claims 1, 5, 9 and 13 under 35 U.S.C. § 103(a) have been overcome, and 4) that claims 1, 5, 9 and 13 are patentable over the cited references. Any dependent claim not specifically addressed is deemed allowable in view of its dependency from an independent claim as argued above. For the reasons presented herein, Appellants respectfully request the removal of the present rejections and allowance of the present claims.

Fee for Filing Notice of Appeal

A check in the amount of \$500.00 to cover the fee for filing a Notice of Appeal under 37 C.F.R. § 41.31 required under 37 C.F.R. § 41.20(b)(1) was previously submitted with a prior Notice of Appeal filed on March 8, 2006.

Fee for Filing a Brief in Support of Appeal

Enclosed is a check in the amount of \$500.00 to cover the fee for filing a brief in support of an appeal required under 37 C.F.R. § 41.20(b)(2).

Fee for Extension of Time

This Brief is filed within four months from the date of filing the Notice of Appeal. Enclosed is a check in the amount of \$450.00 to cover the fee for a two month extension of time required under 37 C.F.R. § 1.17(a)(2) pursuant to 37 C.F.R. § 1.136(a).

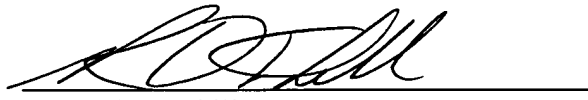
Charge Our Deposit Account

If there are any further charges not accounted for herein, please charge them to our deposit account No. 02-2666.

Respectfully submitted,

BLAKELY, SOKOLOFF, TAYLOR & ZAFMAN LLP

Dated: 7-10, 2006


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IX. CLAIMS APPENDIX

The claims on appeal read as follows:

1. A method, comprising:
updating a message from a first version to an upgraded version by chaining through intermediate versions, wherein updating comprises:
receiving an update message having a first version format; and
repeatedly generating a revised update message having a next most recent version format based on the update message until a final update message having an upgraded version format is generated.
2. The method of claim 1, wherein generating a revised update message having a next most recent version format includes:
receiving a first update message; and
calling a next most recent version mapping function to map contents of the first update message to generate a second update message.
3. The method of claim 1, wherein the update message includes a set of records for a database in the first version.
4. The method of claim 3, wherein the set of records for the database in the first version is a complete set of records for the database.

5. An article of manufacture comprising:
a computer readable medium having instructions stored thereon, which when executed by a data processing system, causes the data-processing system to perform a method, comprising:
receiving an update message having a first version format; and
generating repeatedly a revised update message having a next most recent version format based on the update message until a final update message having an upgraded version format is generated.
6. The article of manufacture of claim 5, the method further comprising:
receiving a first update message; and
calling a next most recent version mapping function to map contents of the first update message to generate a second update message.
7. The article of manufacture of claim 5, wherein the update message includes a set of records for a database in the first version.
8. The article of manufacture of claim 7, wherein the set of records for the database in the first version is a complete set of records for the database.
9. An apparatus for updating a message from a first version to an upgraded version by chaining through intermediate versions comprising:
means for receiving an update message having a first version format; and

means for repeatedly generating a revised update message having a next most recent version format based on the update message until a final update message having an upgraded version format is generated.

10. The apparatus of claim 9, further comprising:
means for receiving a first update message; and
means for calling a next most recent version mapping function to map contents of the first update message to generate a second update message.

11. The apparatus of claim 9, wherein the update message includes a set of records for a database in the first version.

12. The apparatus of claim 11, wherein the set of records for the database in the first version is a complete set of records for the database.

13. An apparatus, comprising:
a network switching device to receive an update message having a first version format; and,
a controller card to update a message from a first version to an upgraded version by chaining through intermediate versions, the controller card to repeatedly generate a revised update message having a next most recent version format based on the update message until a final update message having an upgraded version format is generated.

14. The apparatus of claim 13, wherein the network switching device receives a first update message.

15. The apparatus of claim 14, further comprising:
a mapper to call a next most recent version mapping function to map contents of the first update message to generate a second update message.

16. The apparatus of claim 13, wherein the update message includes a set of records for a database in the first version.

17. The apparatus of claim 16, wherein the set of records for the database in the first version is a complete set of records for the database.